

### REMARKS

In the Office Action the examiner has rejected all of the claims as being unpatentable over Molne in view of Brown or Lee. In order to render the claims obvious the prior art publications must disclose every limitation of the claimed subject matter. Any combination of Molne, Brown or Lee fails this stringent test with regard to the amended claims.

The current invention relates to a method and apparatus for establishing a roaming service for a mobile telephone in which a list of preferred mobile networks is stored on a Subscriber Identity Module (SIM) and used to modify PLMN selector data in the telephone so that the preferred networks have preference over user defined and other mobile networks. The invention has the advantage that the network operator (which provides the SIM) can control the networks to which the mobile telephone connects when roaming.

Molne describes a system in which a list of preferred mobile networks is stored on a SIM for use in network selection. However, Molne does not disclose that the list is used to modify PLMN data so that networks in the list have preference over user-defined and other networks, such as networks with higher signal strength. Molne discloses that the list stored on the SIM can be modified by both the user and the operator (column 3 lines 53 to 55). Molne specifically teaches away from the use of a preferred list of networks that have preference over user-defined networks because the list in Molne is user definable.

Brown teaches a method and apparatus for reducing power consumption in a mobile telephone in which a first list of networks is used to create a second ordered list of preferred networks having signal strengths above a predetermined level. Brown does not teach using either list to modify the PLMN selector of the mobile telephone. Nor does Brown teach that the preferred networks should have preference over user-defined and other networks with signal strengths above a

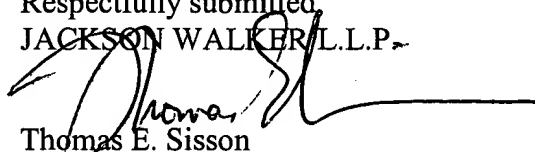
predetermined level in random order. Brown specifically teaches that networks having a signal strength above the predetermined level should have preference.

The applicant submits that a combination of Molne and Brown does not meet the strict requirement of teaching every limitation of the independent claims. Furthermore, the applicant submits that the teachings in Molne and Brown cannot be rightly combined because they teach alternatives for achieving a similar result. Both Molne and Brown teach the use of a list of preferred networks but Molnes teaches modifying the list through user input or operator commands whereas Brown teaches modifying the list dependent upon received signal strengths. The two methods of modifying the list are mutually exclusive.

Lee teaches a system for providing a roaming service in a mobile telephone in which the telephone determines the mobile system to use for a particular location by selecting a preferred system from a database stored in the mobile telephone. The database can be equated to a list of preferred networks. Lee teaches choosing a preferred network based on location, frequency band, setup channels and system type. Lee does not teach modifying the list (database) in any way. Nor does Lee teach using the list to modify a PLMN selector of the mobile telephone so that networks in the list take preference over user-defined networks or other networks.

The applicant submits that a combination of Molne and Lee does not meet the requirement of disclosing every limitation of the independent claims.

Respectfully submitted,  
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Date: 2-25-2005

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